

### REMARKS

This application has been carefully reviewed in light of the Office Action dated December 8, 2009. Claims 1, 5, 7 to 9, 11 to 13, and 15 to 22 are in the application, with Claims 1 and 20 being independent. Reconsideration and further examination are respectfully requested.

Claims 1, 5, 7 to 9, 11 to 13, and 15 to 19 were rejected under 35 U.S.C. § 112, second paragraph. These rejections are respectfully traversed, and are submitted to have been obviated by the amendments made herein.

Claims 1, 5, 7 to 9, 11 to 13, and 15 to 19 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,235,427 (Idota) in view of U.S. Publication No. 2002/0146623 (Suzuki) and U.S. Patent No. 6,322,926 (Kasashima). Claim 19 was rejected under 35 U.S.C. § 103(a) over Idota, Suzuki, and Kasashima, and further in view of WO 2001/41249 (Nakanishi). Claims 20 to 22 were rejected under 35 U.S.C. § 103(a) over Idota. These rejections are respectfully traversed.

According to one feature of the claims as recited by Claims 1 and 20, the oxide film comprises an oxide of an element selected from the group consisting of aluminum, titanium, vanadium, yttrium, and zirconium.

By virtue of the above-discussed feature, it is possible to suppress the production of silicon oxide, and thereby increase the efficiency of the electrochemical insertion/release of lithium. See, for example, page 24, line 18 to page 25, line 4 of the instant specification.

None of Idota, Suzuki, Kasashima, and Nakanishi, even in the proposed combinations, assuming, *arguendo*, that such could be combined, is seen to disclose or

suggest at least the above-discussed feature.

The dependent claims are also submitted to be patentable because they set forth additional aspects of the claims and are dependent from the independent claims discussed above. Therefore, separate and individual consideration of each dependent claim is respectfully requested.

The application is believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

No fees are believed due; however, should it be determined that additional fees are required, the Director is hereby authorized to charge such fees to Deposit Account 06-1205.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should be directed to our address given below.

Respectfully submitted,

/Damond E. Vadnais/  
Damond E. Vadnais  
Attorney for Applicants  
Registration No. 52,310

FITZPATRICK, CELLA, HARPER & SCINTO  
1290 Avenue of the Americas  
New York, New York 10104-3800  
Facsimile: (212) 218-2200

FCIS\_WS 4784279v1